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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,947	12/26/2001	Hsuan-Yin Lan-Hargest	12938-003002	8464

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EXAMINER

ZUCKER, PAUL A

ART UNIT PAPER NUMBER

1621

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,947

Applicant(s)

LAN-HARGEST ET AL.

Examiner

Paul A. Zucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26,80-94,96,97 and 99-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26,80-94,96,97 and 99-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 February 2005 has been entered.

Current Status

2. This action is responsive to Applicants' amendment of 22 February 2005.
3. Receipt and entry of Applicants' amendment is acknowledged.
4. Applicants' cancellation of claims 95 and 98 is acknowledged.
5. Applicants' addition of new claim 103 is acknowledged.
6. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, and 80-94, 96, 97 and 99-103 are pending.
7. The objection to the claims set forth in paragraph 5 of the previous Office Action mailed 22 November 2004 is withdrawn in response to Applicant's amendment.
8. The rejection under 35 USC § 112, second paragraph, set forth in paragraph 6 of the previous Office Action mailed 22 November 2004 is withdrawn in response to Applicant's amendment.
9. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-90 and 102 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoorspool et al (Monatshefte fuer Chemie,

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Preparation of Phenoxy Radicals, 1967, 98(4) pages 1256-1261, English Translation). Hoorspool discloses (Translation, Page 7, lines 14-21) the synthesis of the compound 5-phenoxy-2,4-pentadienoic acid (all *trans*) by hydrolysis of the corresponding methyl ester with KOH in aqueous alcohol. This compound corresponds to a compound of formula (I) in which A is unsubstituted phenyl and $Y^1 = O$, $Y^2 =$ a bond. Hoorspool further discloses (ibid) that this compound is precipitated from aqueous HCl solution and recrystallized from alcohol solution. The Examiner considers both solutions to be pharmaceutical compositions with the solvents corresponding to pharmaceutically acceptable carriers.

Examiner's Response to Applicants' Remarks with Regard to This Rejection

10. Applicants' have argued that Hoorspool does not teach the compound 5-phenoxy-2,4-pentadienoic acid or compositions thereof but rather the corresponding methyl ester. The Examiner disagrees and directs Applicants' attention to Hoorspool (Translation, Page 7, lines 14-21) in support of his position.

Applicant's arguments filed 22 February 2005 have been fully considered but they are not persuasive for the reasons indicated above.

11. The rejection under 35 USC § 102 set forth set forth in paragraph 8 of the previous Office Action mailed 22 November 2004 is withdrawn in response to Applicant's amendment.

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New Objections and Rejections

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Specification

12. The disclosure is objected to because of the following informalities: Applicants should amend the first sentence of the specification to reflect the current status of the parent application. Appropriate correction is required.

Claim Rejections - 35 USC § 112

13. Claims 96 and 97 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 96 recites the limitation "C₁₋₂ alkyl" in line 3. There is insufficient antecedent basis for this limitation in the claim. Claim 96 and its dependent are therefore rendered indefinite.

Claim Rejections - 35 USC § 102

14. Claims 1-5, 12, 13, 22 and 80-84, 87, 87-94, 96, 97 and 99-103 are rejected under 35 U.S.C. 102(b) as being anticipated by Roedig et al (Liebig's Annalen der Chemie, Synthese und Thermische Umlagerung von cis-Pentachlo-pentadienen zu Tetrachlorbutadien-carbonsäurechloriden, 1974 pages 630-643). Roedig discloses (Page 633, line 9; see page 631, lines 9-13 for R group definitions **g-l**) the 1,2,3,4-tetrachloro-2,4-butadienoic acids **9** which when R is cyclohexyl, naphthyl or

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substituted phenyl (methyl, chloride) correspond to compounds that are instantly claimed. Roedig discloses (Page 640, last paragraph-page 642, first paragraph, inclusive) these compounds and their physical properties as well as acetic acid solutions thereof. Roedig discloses (Page 641, lines 19-24) a mixture of all stereoisomers of the *p*-tolyl compound that can be presumed to contain the all-*trans* isomer. Roedig also discloses (Page 641, lines 30-34) the *cis,trans*- isomer of 1,2,3,4-tetrachloro-4-*p*-tolyl-2,4-butadienoic. Roedig, therefore anticipates claims 1-5, 12, 13, 22 and 80-84, 87, 87-94, 96, 97 and 99-103.

Conclusion

15. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, and 80-94, 96, 97 and 99-103 are pending. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, and 80-94, 96, 97 and 99-103 are rejected.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAULA A. ZUCKER, PH.D.
PRIMARY EXAMINER